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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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7590 01/13/2005

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EXAMINER

YAO, SAMCHUAN CUA

ART UNIT	PAPER NUMBER
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1733

DATE MAILED: 01/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Art Unit: 1733

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 7-14, 16-20, and 22-28 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In claim 7, the claim recitation of having at least one finger on first and second sides raises an issue of New Matter. The original disclosure teaches providing 1st and 2nd sides of the metal covers with multiple fingers (see element 26 of figure 3). There is no suggestion in the original disclosure of using a finger on 1st and 2nd sides. In fact, in two separate declarations made by Mr. Paul Mercadante and Mr. Mark Moshayedi in Application No. 08/092,012 (now U.S. Patent 5,397,857) Paper No. 7, it was stated in numbered paragraph 4 that *"Duel's product's superiority over the other available products is due to the unique construction of the cover halves which interperses a plastic frame within the metal elements or cover. This allows assembly of the package far more rapidly than with other products, and yields a superior package result."* (emphasis added). If there is only a finger on the 1st and 2nd sides of the cover, how can each cover interperses a plastic frame? Moreover, Counsel also argues in Paper No. 6 on pages 3-4 in application '012, the critically of *"protruding metallic fingers"* to the invention as evidence from the following passage *"The technique includes the use*

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: a reference number for an energy director element 22 is missing in the figures. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.
2. The proposed drawing correction and/or the proposed substitute sheets of drawings filed on 09-07-99 have been disapproved because they introduce new matter in the drawings. 37 CFR 1.121(a)(6) states that no amendment may introduce new matter into the disclosure of an application. The original disclosure does not provide sufficient support for an energy director 22 which forms a V-shaped groove to a surface of a frame element.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

of protruding metallic fingers on the cover ... The present invention accomplishes this by means of the multiple fingers 26 ... (emphasis added).

In claims 9 and 16, the recitation of having fingers from at least two sides also raises an issue of New Matter. These claims read on having fingers on all sides of the metallic cover. As clearly illustrated in figure 3, only the 1st and 2nd sides of each cover are provided with fingers. . It should be noted that, in column 3 lines 27-28 of U.S. Patent '857, it discloses "... metal fibers 26 are provided on each side of the covers 12 & 14.". One in the art, reading this passage in the context of figures 2 and 3 as disclosed in column 3 lines 12-28, would not reasonably conclude that the original disclosure teaches providing fingers on all sides of each cover.

In claim 11, the claim recitation of "*with at least one finger extending from each said sides of each cover*" raises an issue of New Matter for the same reasons set forth above.

In claim 17, the claim recitation of "the edge of the metal cover is bent ..." raises an issue of New Matter. The original disclosure does not provide sufficient support to require a singular edge being bent. More important, it is unclear how this claim further limit claim 11. Claim 11 requires multiple edges to be bent.

In claim 18, this claim now requires only one edge, instead of multiple edges, to be bent to conform to a shape of a frame. In addition, this claim does not also require having fingers extending from each of 1st and 2nd sides. Equally important, the second package half does not even require having any edge to be bent to conform to a shape of the frame and require having fingers extending from the sides of second package half.

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Application No. 08/818,520

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Office Action Summary

Application No.

08/818,520

Applicant(s)

FARQUHAR ET AL.

Examiner

Sam Chuan C. Yao

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14, 16-20 and 22-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-6 is/are allowed.
- 6) ☒ Claim(s) 7-14, 16-20 and 22-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

In other words, the recited second package half reads on a flat metal sheet with a molded frame bonded to it. The presently recited limitations of this claim do not have sufficient support in the original disclosure.

In claims 22-23, the claims recitation of *"a finger extends ... the frame element is injection molded partially around the edge"* (emphasis added) raise an issue of New Matter. The original disclosure may provide support for generically requiring a frame element to be injection molded around the edges or fingers. However, there is suggestion that Counsel has in possession of ONLY injection molding a frame element *"partially around the edge"*. In fact, figure 4 shows that the edge is fully embedded by the injection molded frame element.

In claim 24, the limitations in this claim reads on having fingers to all sides of each cover. There is no sufficient support in the original disclosure for this embodiment. As noted above, figure 3 clearly shows that only the 1st and 2nd sides of each cover are provided with fingers.

In claim 25, according to Counsel on page 9 in the Appeal brief, the claimed language *"means for securing ..."* encompasses, *"A variety of equivalents to the disclosed means structure could be imagined, for example, first and second covers do not need to be bent to conform to the shape of the corresponding first and second frame elements or they can be partially bent to conform, or only one of the elements needs to be bent to conform."* (emphasis added); and then on page 20, Counsel further states that the equivalence of the disclosed structure can also be those that *"... do not include fingers and have a bent cover; perhaps only have one finger on each side of the cover;*

or the covers are bent but are not bent to conform to the frames or wherein only one of the covers is bent." (emphasis added). The disclosure of the application relied upon does not reasonably convey to the artisan that the inventor had possession at that time of the later claimed subject matter of: a) not requiring multiple fingers on the 1st and 2nd sides; b) not requiring multiple edges to be bent; c) requiring partially bent edges; d) requiring edges to be bent, but without requiring, the edges to be bent to conform to the frames; and, e) requiring only one of the covers to be bent.

In claim 26, the limitation in this claim does not require multiple fingers. This raises an issue of new Matter for reasons set forth above.

In claim 27, the limitation in this claim reads of having fingers on all sides of each cover. This raises an issue of new Matter for reasons set forth above.

In claim 28, the claim recitation of "... each of the edges including protruding portions, the protruding portions adjacent open portions providing voids" reads on (for example) an end surface of each of the edges having a plurality of spaced-apart small spherical bumps projecting from the end surface. The original disclosure fails to reasonably convey that Applicant has in possession this newly added subject matter at the time of filing.

Reissue Applications

5. This reissue application was filed without the required offer to surrender the original patent or, if the original is lost or inaccessible, an affidavit or declaration to that effect. The original patent, or an affidavit or declaration as to loss or accessibility of the

original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

6. Claims 7-14, 16-20, and 22-28 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Background:

To determine whether there is an improper recapture of claimed subject matter deliberately canceled in the application for the patent upon which the present reissue is based, it is imperative to review the record of the parent (S.N. 08/092,102) of this reissue application as a whole. In other words, one must review the commulative limitations added to the claims as well as Counsel's arguments to determine whether there is an improper recapture of claimed subject matter.

The invention relates to memory card cover halves, wherein each cover half includes a metal cover having sides from which "*fingers*" extend. The "*fingers*" are embedded in, or otherwise integrally attached to (e.g., by injection molding), a plastic "frame element" also included in each cover half.

The original article claims included the limitation that the "*fingers*" are "*embedded in the plastic frame elements*" (hereinafter, the *embedded fingers limitation*). In response to the examiner's first Office action prior art rejection, applicants amended the independent claim so as to eliminate the *embedded fingers limitation* in favor of a limitation reciting "*plastic frame elements forming an integral unit*" (hereinafter, the *integral frame limitation*) and a limitation reciting "the plastic frame elements being injection molded around the fingers" (hereinafter, the *injection molding limitation*). In addition, on pages 3-4, Counsel argues the criticality of injection molding and "*protruding metallic fingers*" to the invention as evidence from the following passage "*The technique includes the use of protruding metallic fingers on the cover ... The present invention accomplishes this by means of the multiple fingers 26 ...*" (emphasis added). To further emphasize the importance of using multiple fingers, Counsel further submitted two separate declarations made by Mr. Paul Mercadante and Mr. Mark Moshayedi in Application '102 Paper No. 7. In both declarations, it was stated in numbered paragraph 4 that "*Duel's product's superiority over the other available products is due to the unique construction of the cover halves which intersperses a plastic frame within the metal elements or cover. This allows assembly of the package far more rapidly than with other products, and yields a superior package result.*" (bold face and emphasis added).

(There were 35 U.S.C.112, 2nd paragraph, rejections that were made, but the record is clear that the amendments to claim 1 were not made in response to those rejections.)

The application was later allowed, with an examiner's amendment that was required by the examiner.

The following three aspects of the original application prosecution are especially relevant to evaluating recapture in the present reissue.

I. The examiner's amendment added the *embedded fingers limitation* back into the independent claim. In addition, the *integral frame limitation* and the *injection molding limitation* were retained in the independent claim that issued in the original patent.

Accordingly, these 3 limitations were required to obtain allowance of the original application claims. As explained in paragraph II below, 2 more limitations were also required.

II. In order to obtain allowance of the original application claims, applicants agreed to an examiner's amendment adding the following new limitations to the independent claim: (1) "each cover has a first and second side" from which the fingers extend (hereinafter, the *first and second sides limitation*), and (2) the "edges of the metal covers are bent to conform to the shape of the frame..." (hereinafter, *bent edges limitation*).

III. The original application claims to the article always recited a "plurality of fingers" (hereinafter, the *plurality of fingers limitation*). As noted earlier, the *plurality of fingers limitation* was relied upon in applicants' argument to define over the art. For example, the declarations made by Paul Mercadante and Mark Moshayedi in Paper No. 7, state

that "Duel's product's superiority over the other available products is due to the unique construction of the cover halves which intersperses a plastic frame within the metal elements or cover." (Emphasis added.) On page 7 of the August 8, 1994 amendment (Paper No. 6), applicants argued that "*the declarations of Paul Mercandante and Mark Moshayed... confirm that the product embodying this invention represents an advancement over the prior art in the field.*" Thus the criticality of the *plurality of fingers limitation* was argued by applicants to distinguish over the prior art

Based on paragraphs I - III above, the following 6 elements were added (Elements 1-5) or argued (Element 6) in order to obtain allowance of the original application claims.

Element 1: the *embedded fingers limitation* (i.e., "embedded in the plastic frame elements").

Element 2: the *integral frame limitation* (i.e., "plastic frame elements forming an integral unit").

Element 3: the *injection molding limitation* (i.e., "the plastic frame elements being injection molded around the fingers").

Element 4: the *first and second sides limitation* (i.e., "each cover has a first and second side")

Element 5: the *bent edges limitation* (i.e., "edges of the metal covers are bent to conform to the shape of the frame...").

Element 6: the *plurality of fingers limitation* (i.e., "a plurality of fingers").

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In the present instance, the claims which were rejected by the examiner based on prior art did not contain Elements (1-5). The claims did contain the Element (6) limitation. To overcome the prior art rejection against the claims, the applicants rewrote of the claims to add Elements (1-5) and also relied in their argument on Element (6). The applicants made the choice of inserting Elements (1-5) and specifically relying upon Element (6) for all of the claims that were allowed in the patent. The applicant chose not to prosecute variations of the original claims not including Elements (1-6). At the present, on reissue, applicant is not permitted to completely delete these elements by way of the reissue claims (the specifics of the claim deletion of elements will be explained in the next paragraph) . See *Pannu v. Storz Instruments, Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001), discussed below as to the situation where there was amendment to surrender claim subject matter. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998) for the principle that limitations relied upon to define patentability, although they were not added via amendment in the original application, will establish a surrender of claim subject matter.

As explained above, elements 1-6 are the limitations relied upon to obtain allowance of the application claims and issuance of patent (i.e., the surrender-generating limitations). The reissue claims omitting these elements are as follows:

- (1) Reissue claims 7-9, 11-14, 16-20, 22, 23 and 25-28 do not contain element 1 (the *embedded fingers limitation*), or any intermediate thereof.
- (2) Reissue claims 11, 12, 14, 16-20, and 22-27 do not contain element 2 (the *integral frame limitation*), or any intermediate thereof.
- (3) Reissue claims 25 and 26 do not contain element 3 (the *injection molding limitation*), or any intermediate thereof.

(4) Reissue claims 18-20, and 22-27 do not contain element 4 (the *first and second sides limitation*), or any intermediate thereof.

(5) Reissue claims 18 and 25 do not contain element 5 (the *bent edges limitation*), or any intermediate thereof.

(6) Reissue claims 7, 10-14, 16, 18-20, and 22-26 do not contain element 6 (the *plurality of fingers limitation*).

It is worth noting that, even without considering the record of Application '102 as a whole, and only relying on Counsel's own admission on page 21 full paragraph 1, it is readily apparent that there is an improper recapture of claimed subject matter. According to Counsel, the limitation of having "edges of the metal covers [being] bent to conform to the shape of the frame" (insertion in original; emphasis added) was the one which placed the application in condition for allowance. Note this limitation requires multiple edges of multiple covers are bent. However, claim 18 only requires one edge, instead of multiple edges, to be bent to conform to a shape of a frame. Equally important, the second package half does not even require having any edge to be bent to conform to a shape of the frame and require having fingers extending from the sides of second package half (i.e. this reads on a flat metal sheet). However, the limitation which placed the application in condition for allowance requires multiple edges being bent for both covers. Moreover, this claim does not also require having fingers extending from each of 1st and 2nd sides which was deemed critical to the invention by Counsel in Application '102 as noted above. Moreover, according to Counsel's own admission on page 21, "... *the bent edges of the metal covers was the limitation that resulted in allowance of the claims over the prior art.*" (bold face and emphasis added). Note that the added limitation requires having multiple edges being bent for both covers not just one of the covers. However, according to Counsel on page 9 in the Appeal brief, the claimed language

"means for securing ..." encompasses "A variety of equivalents to the disclosed means structure could be imagined, for example, first and second covers do not need to be bent to conform to the shape of the corresponding first and second frame elements or they can be partially bent to conform, or only one of the elements needs to be bent to conform. and on page 20, Counsel further states that the equivalence of the disclosed structure can be those that "... do not include fingers and have a bent cover; perhaps only have one finger on each side of the cover; or the covers are bent but are not bent to conform to the frames or wherein only one of the covers is bent." (emphasis added). Equally important, as noted above, claims that do not require multiple fingers are taken to be improper recapture of claimed subject matter.

Elements (1 – 5) of the original patent are germane to what was surrendered in response to a prior art rejection, as the independent claim was rejected over prior art until the limitations of Elements (1-5) were added. Therefore, Elements (1 – 5) of the original patent were added in order to secure a patent. Similar to the facts in *Pannu v. Storz Instruments, Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001), the applicant has broadened the reissue claims in an aspect germane to what was surrendered in response to the prior art rejection, and has narrowed in some aspects not related to the surrender. It is noted that the Appeal Brief states on page 21 that reissue claims 18, 24 and 28 "are even more narrow than the original claims by describing the frame elements as being 'sonically bonded'." However, there is no replacement narrowing limitation that relates to any of the five surrender-generating limitations. The decision in *Pannu* is on point as to the issues on appeal, because it provides an actual fact situation in which

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this scenario (claim narrowing in an unrelated area) was held to be recapture. Note also the statement in *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997) that every time the claims are narrowed by amendment, subject matter is surrendered.

Clement, 131 F.3d at 1471, 45 USPQ2d at 1166 ("[E]very time Clement amended his claims, he intentionally omitted or abandoned the claimed subject matter."). This statement that every time the claims are narrowed by amendment, subject matter is surrendered, calls for analyzing reissue claims for whether a key narrowing that was made in the original prosecution has abandoned, i.e., surrendered, subject matter that the patent owner is now seeking to recapture by reissue. Thus, the insertion of a narrowing unrelated to the abandoned (surrendered) claim subject matter that owner is impermissibly trying to recover does not save the claim from the recapture doctrine.

With regard to Element (6), as pointed out above, *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998) is depended upon for the principle that limitations relied upon to define patentability will establish a surrender of claim subject matter, even though they were not added via amendment (in the original application). Again, there is no replacement narrowing limitation that relates to any of the Element (6) surrender-generating limitation.

Remarks on whether *Eggert* applies are as follows:

The facts of the recapture rejection are not analogous to the facts in *Ex Parte Eggert et al*, Appeal No. 2001-0790 (Bd. Pat. App. & Inter. May 29, 2003).

The decision in *Ex Parte Eggert et al*, Appeal No. 2001-0790 (Bd. Pat. App. & Inter. May 29, 2003) is inapplicable to the instant case as the surrendered subject matter does not appear in any of the claims in an intermediate form (i.e., where surrendered subject matter was omitted, it was entirely omitted). Entire omission of surrendered subject matter in a reissue claim, even if it includes other, unrelated limitations making the reissue claim narrower than the patent

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claim in other aspects, is impermissible recapture. As stated in *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597, 1601 (Fed. Cir. 2001), "[o]n reissue, [the patent owner] is estopped from attempting to recapture **the precise limitation** he added to overcome prior art rejections." (Emphasis supplied).

Response to Arguments

7. Applicant's arguments filed on 09-25-00 and 01-11-01 have been fully considered but they are not persuasive. Counsel is directed to Examiner's Answer dated 11-07-04 for responses to Counsel's arguments.

Conclusion

In light of a New Ground of Rejection, the prosecution of this application is being REOPENED, and this office action is made NON-FINAL.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sam Chuan C. Yao whose telephone number is (571) 272-1224. The examiner can normally be reached on Monday-Friday with second Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Blaine Copenheaver can be reached on (571) 272-1156. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Sam Chuan C. Yao
Primary Examiner
Art Unit 1733

Scy
11-16-04